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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
JOHNSON III, HENRY M

ART UNIT	PAPER NUMBER
3739	

DATE MAILED: 03/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/756,130	Applicant(s) HARTH ET AL.	
	Examiner Henry M Johnson, III	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8,10-15,17,18,20-36* is/are rejected.

7)☒ Claim(s) *9,16 and 19* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a) because they fail to show labels 22, 68 or 78 as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character pairs 52 & 54, 62 & 64, 74 & 72, 65 & 69 and 76 & 77 refer to multiple items in the disclosure, yet refer to a single item figures 6A –6C. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities:

Figures 10E and 10F are not listed in the Brief Descriptions of Drawings.

Label 22 on page 10, line 32 is not shown on the drawings.

Cover window 69 on page 14, line 2 is incorrect. Examiner believes it should be 92.

On page 15, lines 28-30, it is disclosed that a fan in the illumination head cools the skin. No such detail is shown in the drawings, in fact the drawings show a tempered glass cover on the assembly, which would appear to block any airflow from such a fan.

On page 16, lines 6-7, 206 is the patient bed, not the treated area and the head, 210, position in relation to 206 does not change as 203 is moved.

On page 16, line 14, the phrase " heads can slightly vertically titled" is incorrect grammar.

On page 18, the second paragraph is confusing as it refers to Figures 10E and 10F without clearly indicating which. It appears 10E is the detail of 352, yet this is not stated. Light 350 should be described in a manner to distinguish it from the treatment lamp.

On page 19, line 19, the word plated is improper, and on line 22 the word maintain is misspelled. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification discloses counting by use of a touch screen display. Without the display, no computerized counting technique has been enabled.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 4-8, 13-15, 17, 18, and 20-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 14, 15, 17, 18, 21, 22, 24, 31, and 32 are rejected as having improper Markush goups in the claim. The following is a quotation of MPEP § 2173.05(h):

> Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C." See Ex parte Markush, 1925 C.D. 126 (Comm'r Pat. 1925).
>
> The use of Markush claims of diminishing scope should not, in itself, be considered a sufficient basis for objection to or rejection of claims. However, if such a practice renders the claims indefinite or if it results in undue multiplicity, an appropriate rejection should be made.

Claim 4 recites the limitation "light source flux" in line 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "illumination light source " in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation "typical size skin area" in line 3. This indefinite term fails to define the area.

Claim 8 recites the limitation "cm2" in line 2. This is quite different from cm^2 which has a definite meaning.

Claim 13 recites the limitation "the score" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 15 recites the limitation "skin treated area" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 25 recites the limitation "said compound group" in line 3, and "light" in line 4. There is insufficient antecedent basis for these limitations in the claim.

Claim 32 recites the limitation "in oil in water emulsion" in line 2. The examiner believes the intent was to state an oil in water emulsion; however, it is indefinite as stated, as the meaning is not clear.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in-
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,324,418 to Crowley et al. Crowley et al discloses a device for tissue that includes at least one light source with a wavelength of 300-500 nanometers (Col. 10, line 67). A control module (Fig. 1 # 8) performs a variety of functions including: regulating the power delivered to the light source, converting the detected light from an analog to a digital signal, and providing the logical function and display driver to the indicators. The optical system includes filters for the light (Col. 10, line 23) and a lens (Col. 10, line 44).

Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 5,896,457 to Tyrrel. Tyrrel teaches a device using multiple light sources, one of which is blue (Col. 11, line 26). The blue spectrum has as its shortest wavelength, 420 nanometers. Control circuitry is provided to enable the light source (Col. 10, line 21). The device includes optics in the form of a lens (Col. 12, line 35) to produce various patterns and an adjustable fixture for positioning the light (Fig. 1).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21, 22 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,576,013 to Williams et al. Williams et al teaches the photodynamic treatment of tissue using photosensitizing agents such as methylene blue (Col. 5, line 26) and light with wavelengths of 514 nm, 550 nm and 610 nm specifically (Col. 5, line 10-20). The illumination step includes illuminating the area a plurality of times (Col. 10, line 9). It is inherent that the illumination source would have to be supported by some means and that an interval would exist between the plurality of illuminations.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,576,013 to Williams et al in view of U.S. Patent 6,269,818 to Lui et al. Williams et al is discussed above, yet does not specifically disclose the treatment of acne or seborrhea. Lui et al teaches the treatment of acne using light (table II) and references numerous studies in this area dating back to 1927 (Col. 1, line 48). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the

method of Williams et al, using photosensitizing compounds, to treat acne as taught by Lui et al to complement the effects of light alone.

Allowable Subject Matter

No claims are allowed.

Claims 4-8, 15, 17, 18, 26, and 29-36 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 9, 16, and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 2,183,726 to Sommer et al teaches the use of blue light in treating skin. U.S. Patent 6,183,500 to Kohler discloses an acne treatment apparatus using blue light in the 400 to 450 nm range. U.S. Patent 6,223,071 to Lundahl et al teaches a photodynamic device with a blue light of 417 nm.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M Johnson, III whose telephone number is (703) 305-0910. The examiner can normally be reached on Monday through Friday from 7:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Hmj
March 13, 2002

Lee Cohen
Primary Examiner